

Docket No.: AB-126U

Remarks

Applicant, herein, has canceled claims 2, 4-6, 19 and 20, and has amended claims 1, 3, 17, 21, 22 and 24. Eighteen (18) claims remain pending in the application: claims 1, 3, 7-18, and 21-24. Applicant respectfully requests reconsideration of the pending claims, in view of the claim amendments above and comments below.

Claim Rejections - 35 USC § 112

In paragraph 1 of the Office Action mailed September 15, 2003, claims 3 and 5 were rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, in claim 3, "greater than about 100 to 150 Hz" was considered indefinite, and claim 5 was considered to have similar problems.

Applicant has herein amended claim 3 to state "greater than about 100 Hz" to overcome this rejection. Applicant has also canceled a number of claims herein, including claim 5, rendering moot the rejection of claim 5 as indefinite.

Claim Rejections - 35 USC § 103

In paragraphs 2, 3 and 4 of the Office Action, claims 1, 6, 13-16 and 20-24 were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926). In addition, in paragraphs 5-8 of the Office Action, claim 2 was rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of Silverstone (6161044). Specifically, in paragraph 7, the Examiner states:

Silverstone teaches that the spinothalamic tract is a known pathway for pain impulses and that stimulation along the pathways that carry those impulses can relieve pain (column 1, lines 58-67 and column 2, lines 1-10).

Docket No.: AB-126U

Without necessarily agreeing with the rejections described above, but in order to advance the present application to issuance, applicant has amended claim 1 to incorporate an area of the spine that was included in original claim 2, the ventral commissure. Applicant has similarly amended independent claim 17. This delivery of stimulation pulses to the ventral commissure for treating a patient with chronic pain is not taught or suggested by Silverstone (6161044), alone or in combination with Schulman et al (WO98/37926) or any other art cited by the Examiner. Additionally, the prior art made of record in paragraph 29 of the Office Action does not teach or suggest the invention of the amended claims, which claims should therefore be allowable.

Thus, the rejection of **claims 1, 6, 13-16 and 20-24** in paragraphs 2-4 and the rejection of **claim 2** in paragraphs 5-8 have been addressed as follows: Claim 1 has been amended to incorporate the ventral commissure site of claim 2, which applicant believes makes claim 1 allowable. Claim 2 has been canceled. Claim 6 has also been canceled. Claims 13-16 depend from claim 1, which should now be allowable. Claim 20 has been canceled. Claims 21-24 have been amended to depend, directly or indirectly, from independent claim 17, which has also been amended to incorporate the ventral commissure stimulation site.

In paragraphs 9-12 of the Office Action, **claims 3-5** were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of Zilber (3822708). Claims 4 and 5 have been canceled. Claim 3 has been amended to depend from claim 1. As claim 1 should be allowable for the foregoing reasons, claim 3 should also be allowable. Applicants respectfully request acknowledgement of the same.

In paragraphs 13-16 of the Office Action, **claims 7 and 8** were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of King (6058331). In paragraphs 17-19 of the Office Action, **claims 9 and 10** were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of

Docket No.: AB-126U

Feler et al (6002964). In paragraphs 20-23 of the Office Action, claims 11 and 12 were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of MacDonald et al (5776170). As claims 7-12 depend from claim 1, which should be allowable for the foregoing reasons, claims 7-12 should also be allowable. Applicants respectfully request acknowledgement of the same.

In paragraphs 24 and 25 of the Office Action, claims 17 and 18 were rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of Schulman et al (5358514). In addition, in paragraphs 26-28 of the Office Action, claim 19 was rejected under 35 U.S.C. 103(a) as unpatentable (obvious) over Schulman et al (WO98/37926) in view of Schulman et al (5358514), and further in view of Silverstone (6161044). Independent claim 17 has been amended as described above, to incorporate the ventral commissure site from claim 19. Amended claim 17 should be allowable for the reasons given above for claim 1. Claim 18 depends from amended claim 17, and should therefore also be allowable. Claim 19 has been canceled.

Thus, after amendment as provided herein, all pending claims depend directly or indirectly from independent claim 1 or 17. As such, applicants respectfully request consideration of independent claims 1 and 17, and their dependent claims, in light of these remarks and the related claim amendments.

Docket No.: AB-126U

In view of the foregoing, it is respectfully submitted that the rejections have been overcome and the pending claims are in condition for allowance. An indication of allowability of all pending claims, claims 1, 3, 7-18, and 21-24, at an early date is earnestly solicited.

Respectfully Submitted,

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Date


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